



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

14

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,600	12/04/2001	Dirk Voelkel	RDID01009US	2473

7590 12/16/2003

Roche Diagnostics Corporation
9115 Hague Road, Bldg. D
P.O. Box 50457
Indianapolis, IN 46250-0457

EXAMINER

ROSENBERGER, RICHARD A

ART UNIT PAPER NUMBER

2877

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,600

Applicant(s)

VOELKEL, DIRK

NC ✓

Examiner

Richard A Rosenberger

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 0203.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 26-28 is rejected under 35 U.S.C. 102(b) as being anticipated by Reidel (US 5,801,817).

The reference shows a method for analyzing sample liquids comprising evaluating test elements using an analytical unit. There is a position control unit is used to check whether an analytical area of the test element is positioned correctly (*i.e.*, in or out of the “nominal position”) relative to the analytical unit. The system works by irradiating an area of the test element (12) by a light source (14), detecting radiation reflected from the area (by detectors 32, 34 in figures 3 and 5), and recording (in the circuit of figure 5) a signal (the “correction signal”) generated by the detecting step to check the position (in or out of the “nominal position”) of the analytical area wherein the light source and detector are positioned relative to one another in such a manner that the intensity of radiation reflected from the test element and detected is different when the analytical area is correctly positioned (in the “nominal position”) than the intensity when it is incorrectly positioned (out of the nominal position); as set forth in the reference, the “position control unit”

operates by the fact that the intensity varies as the position of the test strip varies (column 5, lines 14 *et seqq.*)

The analytical unit which produced the measurement as used produced the actual useful measurement at some time less than one second after the position control unit begins to determine the location of the sample; the feedback arrangement to correct the reading based upon the position will be rapid but not instantaneous.

3. Claims 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel (US 5,801,817) as applied to claim 26 above, and further in view of Backhaus et al (US 5,605,838).

Riedel shows a system such as is claimed, determining whether or not the test strip is or is not in the correct ("nominal") position, based upon the detected intensity of light from the test strip. See above. Riedel does not teach using specularly reflected light as in independent claim 15. It is known in the art that optical tests on test strips and the like can be made with specularly reflected light; see Backhaus et al ("Light that is diffusely or specularly reflected from the sample and sample carrier is detected and analysed"; abstract, lines 3-5). It would have been obvious to use specularly reflected light from the sample in this known manner as the light detected by one of the detectors in the device of Riedel because it is a known arrangement which will produce the same type of response as the

scattered light of Reidel. The exact arrangement of the light source and detectors of Reidel can be modified by those in the art because it is the difference in the response of the two detectors based upon the difference in distance that gives the disclosed useful result and the art does not teach or suggest that an exact relationship is necessary.


4. Jina et al , in figure 13, shows using light reflected from the test strip when it is in the correct position to determine whether a test strip is in the correct position for measurement or not based upon a difference between the reflected light from the test element when the test element is correctly positioned and the reflected light when it is incorrectly positioned.

5. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
4 December 2003



Richard A. Rosenberger
Primary Examiner